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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,654	12/21/2000	Michael Hannington	AVERP2850US	7505

7590 09/11/2002

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 09/11/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-10

Office Action Summary	Application No.		Applicant(s)	
	09/742,654		HANNINGTON, MICHAEL	
	Examiner		Art Unit	
	Victor S Chang		1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 32-95 is/are pending in the application.
- 4a) Of the above claim(s) 53-74 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29, 32-52, 75-95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Rejections not maintained are withdrawn.

Election/Restrictions

3. Applicant's election of Group I, claims 1-52, in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 27-29 and 32-52, drawn to an adhesive article with non-adhesive material embedded below the adhesive surface by ink printing, classified in class 428, subclass 343.
 - II. Claims 75-95, drawn to an adhesive article with non-adhesive material embedded flush or below the adhesive surface by sputtering or vacuum deposition, classified in class 428, subclass 343.
5. Inventions Group I and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, Group I requires the non-adhesive

materials embedded below the adhesive surface only, while Group II is made by a different method and the adhesive article has different configuration of having the non-adhesive materials embedded flush or below the adhesive surface.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Heidi Boehlefeld on 9/10/02 a provisional election was made with traverse to prosecute the invention of Group I, claims 27-29 and 32-52. Affirmation of this election must be made by applicant in replying to this Office action. Claims 75-95 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Response to Amendment

8. Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling, substantially for the reasons set forth in section 6 of Paper No. 9, together with the following additional observations.

With respect to Applicant's Response arguing that Applicant has not characterized a route for air bubbles as critical or essential to the adhesive article, it is noted that in the "Summary of the Invention", it states that "The invention relates to an adhesive article which provides air egress." (Specification, page 2, paragraph [0008]). Further, it is also noted that claim 1 does not appear to include any of the structures which provide either air egress, repositionability and/or slidability (Specification, pages

13-14, paragraph [0047]). These aforementioned elements are not inherently present in the claimed genus.

9. Claims 27-29 and 32-52 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is noted that Applicant has provided the methods of embedding the non-adhesive material into the adhesive by using pressure and/or heated rollers or a platen, or winding the article. Applicant discloses that at least a major amount of the non-adhesive material is embedded within the adhesive layer, typically more than 75%, and more than 85% of the thickness of the non-adhesive material (Specification, page 13, paragraph [0048], and page 15, paragraph [0053]). It appears that these methods are conventional, substantially the same as Rusincovitch's methods (Abstract), which only provide a protruded profile of the non-adhesive material on the adhesive surface, as cited in the last Office action. As such, it appears that claims 27-29 and 32-52, which require greater than 100% of the thickness of the non-adhesive material to be embedded and which as such would clearly be unexpected results, are not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC
September 10, 2002

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1900-

1700

Daniel Zinker